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PATENT & TRADEMARK OFFICE

In re Patent Application of: Hans-Jürgen MANN and Wilhelm ULRICH

Art Unit: 2872

Examiner: Thong Q. Nguyen

For: **OBJECTIVE WITH PUPIL OBSCURATION**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

In the Office Action dated April 9, 2004 the Examiner contends that the application contains two patentably distinct inventions, namely:

- I. Species I with claims 2-10 and 17-36 drawn to an objective system having four mirrors and an intermediate image plane as shown in Figure 1; and
- II. Species II with claims 11-16 and 37-43 drawn to an objective system having six mirrors and two intermediate image planes as shown in Figures 2 and 3.

The Examiner found claim 1 to be generic to both of the foregoing species I and II.

In response to the restriction requirement, Applicants hereby provisionally elect Species I with claims 1-10 and 17-36, while at the same time respectfully traversing the election requirement based on the following arguments:

Claims 11-16, which the Examiner found to belong to a separate Species II are only adding additional features (two more mirrors and an additional intermediate image plane). The embodiments of claims 1-9 are recited (in claim 1) as **having** an intermediate image plane and **comprising** first, second, third and fourth mirrors, i.e., using phraseology that does not preclude the possibility of additional intermediate image planes and additional mirrors in any of the claims 1-9. Applicants therefore respectfully disagree with the Examiner's conclusion that claims 11-16 represent a different species. Further in applicants' opinion, claims 37-43 likewise do not represent a separate species, because embodiments with six mirrors and two intermediate image planes are also possible in what the Examiner contends to be Species I.

Consequently, Applicants respectfully request that the Restriction Requirement be withdrawn and that the examination be continued on all of the claims 1-43 of this application.

Dated: May 7, 2004

Respectfully submitted,

By

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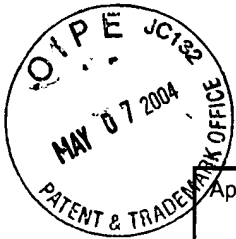
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Application No. (if known): 10/723,600

Attorney Docket No.: 01641/0200095-US0

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Response to Restriction Requirement (2)